

**REMARKS**

This is a full and timely response to the outstanding final Office Action mailed June 15, 2005. Reconsideration and allowance of the application and presently pending claims 1-65, as amended, are respectfully requested.

1. Claim Objection

Claim 49 has been objected to because of an informality cited in the Office Action with regard to the phrase "intended recipient's." The phrase has amended to "intended recipient's identity," as suggested in the Office Action. Therefore, Applicants respectfully request withdrawal of the objection.

2. Response to Rejection of Claim 21 Under 35 U.S.C. §112

Claim 21 has been rejected for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, claim 21 has been amended to overcome the rejection, and Applicants respectfully request withdrawal of the rejection.

3. Response to Rejection of Claims 1-2, 5-6, 8-10, 13-21, 25-37, 40-43, 46-48, 54-56, 58-62, and 64-65 Under 35 U.S.C. §102

In the Office Action, claims 1-2, 5-6, 8-10, 13-21, 25-37, 40-43, 46-48, 54-56, 58-62, and 64-65 stand rejected under 35 U.S.C. §102(e) as allegedly being unpatentable by *Chan* (U.S. Patent No. 6,378,070). For a proper rejection of a claim under 35 U.S.C. Section 102, the cited reference must disclose all elements/features/steps of the claim. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

a. Claims 1-2, 5-6, 8-10 and 13-20

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining a transmitted document at the printout station," as recited in claim 1.

*Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document. . . . [T]he document store 130 receives the message and stores it

appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining a transmitted document at the printout station," as recited in claim 1, since the document store is not co-located with a printer in *Chan*. (Emphasis added). Thus, *Chan* does not anticipate claim 1, and the rejection should be withdrawn.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2, 5-6, 8-10 and 13-20 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that these dependent claims contain all features/steps of independent claim 1. *See, e.g., In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to these dependent claims should be withdrawn.

b. Claims 21 and 25-37

Applicants respectfully submit that independent claim 21 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining the digital document, the encrypted session key and an independently verifiable data record of the intended recipient at a printout station," as recited in claim 21.

*Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document, an 'envelope' for the document (which contains the encrypted session key), and the respective identity of the intended recipient. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining the digital document, the encrypted session key and an independently verifiable data record of the intended recipient at a printout station," as recited in claim 21, since the document store is not co-located with a printer in *Chan*. (Emphasis added). Thus, *Chan* does not anticipate claim 21, and the rejection should be withdrawn.

Because independent claim 21 is allowable over the cited art of record, dependent claims 25-37 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that these dependent claims contain all features/steps of independent claim 21. Accordingly, the rejection to these dependent claims should be withdrawn.

c. Claim 40

Applicants respectfully submit that independent claim 40 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining a transmitted document at the printout station," as recited in claim 40.

*Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining a transmitted document at the printout station," as recited in claim 40. (Emphasis added). Thus, *Chan* does not anticipate claim 40, and the rejection should be withdrawn.

d. Claims 41-43 and 46-48

Applicants respectfully submit that independent claim 41 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the features of "a communications module for receiving an electronic version of the transmitted document over a communications network, receiving an independently verifiable data record of the intended recipient, and receiving a first token of the intended recipient" and "a store for securely retaining the transmitted document, the transmitted independently verifiable data record and the first token," as recited in claim 41.

*Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document, an 'envelope' for the document (which contains the encrypted session key), and the respective identity of the intended recipient. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest a first token being received and stored with the transmitted document and independently verifiable data record, as described in claim 41 (e.g., where "the intended recipient has proved their identity by use of a second token that is uniquely related to the first token"). For example, a session key, as described in *Chan* is not equivalent to a first token, as described in claim 41. Thus, *Chan* does not anticipate claim 41, and the rejection should be withdrawn.

Because independent claim 41 is allowable over the cited art of record, dependent claims 42-43 and 46-48 (which depend from independent claim 41) are allowable as a

matter of law for at least the reason that these dependent claims contain all features/elements of independent claim 41. Accordingly, the rejection to these dependent claims should be withdrawn.

e. Claims 54-56 and 58-59

Applicants respectfully submit that independent claim 54 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining the transmitted document and receiving the data record at the second station," as recited in claim 54.

*Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document, an 'envelope' for the document (which contains the encrypted session key), and the respective identity of the intended recipient. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining the transmitted document and receiving the data record at the second station," as recited in claim 54. (Emphasis added). Thus, *Chan* does not anticipate claim 54, and the rejection should be withdrawn.

Because independent claim 54 is allowable over the cited art of record, dependent claims 55-56 and 58-59 (which depend from independent claim 54) are allowable as a matter of law for at least the reason that these dependent claims contain all features/steps of independent claim 54. Accordingly, the rejection to these dependent claims should be withdrawn.

f. Claims 60-62

Applicants respectfully submit that independent claim 60 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the feature of "receiving and securely retaining the transmitted document and receiving the data record at the second station," as recited in claim 60.

*Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document, an 'envelope' for the document (which contains the encrypted session key), and the respective identity of the intended recipient. . . . [T]he document store 130

receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "receiving and securely retaining the transmitted document and receiving the data record at the second station," as recited in claim 60. (Emphasis added). Thus, *Chan* does not anticipate claim 60, and the rejection should be withdrawn.

Because independent claim 60 is allowable over the cited art of record, dependent claims 61-62 (which depend from independent claim 60) are allowable as a matter of law for at least the reason that these dependent claims contain all features/steps of independent claim 60. Accordingly, the rejection to these dependent claims should be withdrawn.

g. Claims 64-65

Applicants respectfully submit that independent claim 64 is allowable for at least the reason that *Chan* does not disclose, teach, or suggest the features of "communicating to the printout station and securely retaining the encrypted digital document at the printout station," "communicating an independently verifiable data record of the intended recipient to the printout station, the independently verifiable data record comprising the intended recipient's public key," and "communicating the independently verifiable data record comprising the intended recipient's public key to a remote device," as recited in claim 64.

*Chan* is apparently limited to at most a system wherein "the secure printing process forwards across the network 110, to the document store 130, a message comprising the encrypted document, an 'envelope' for the document (which contains the encrypted session key), and the respective identity of the intended recipient. . . . [T]he document store 130 receives the message and stores it appropriately to hard disk 135." Col. 6, lines 48-54. Therefore, *Chan* fails to teach or suggest the step of "communicating to the printout station and securely retaining the encrypted digital document at the printout station," as recited in claim 64. (Emphasis added). Additionally, *Chan* fails to teach or suggest "communicating an independently verifiable data record of the intended recipient to the printout station, the independently verifiable data record comprising the intended recipient's public key," and "communicating the independently verifiable data record comprising the intended recipient's public key to a remote device," as recited in claim 64. For example, a session key, as described in *Chan* is not equivalent to a public key, as described in claim 64. Thus, *Chan* does not anticipate claim 64, and the rejection should be withdrawn. Further, since claim 65 depends from independent claim 64, claim 65 is also

not anticipated by *Chan* for at least this reason. Accordingly, the rejection to this claim should also be withdrawn.

4. Response to Rejection of Claims 3-4, 7, 11-12, 22-24, 38-39, 44-45, 49-53, 57, and 63 Under 35 U.S.C. §103

In the Office Action, claim 7 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Menezes* (Handbook of Applied Cryptography). Claims 11-12, 38-39, 57, and 63 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Schneier* (Applied Cryptography). Claims 3-4, 22-24, 44-45, and 49-53 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Chan* in view of *Lundblad* (EP Patent Publication No. 0542703 A1).

All of the claimed features of independent claims 1, 21, 41, 49, 54, and 60 are not taught and suggested by *Chan*, as previously discussed. Further, the cited art of *Menezes*, *Schneier*, and *Lundblad* fails to cure the deficiencies of the *Chan* reference in suggesting or teaching all of the claimed features in claims 3-4, 7, 11-12, 22-24, 38-39, 44-45, 49-53, 57, and 63 (which depend from respective independent claims 1, 21, 41, 49, 54, and 60). Therefore, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Chan* with the cited art has not been made. Therefore, the rejections of claims 3-4, 7, 11-12, 22-24, 38-39, 44-45, 49-53, 57, and 63 should be withdrawn.

5. Response to Rejection of Claims 1-2, 5-11, 13-18, 41-43, 46-48, 54-56, 58, and 60-62 Under 35 U.S.C. §102

In the Office Action, claims 1-2, 5-11, 13-18, 41-43, 46-48, 54-56, 58, and 60-62 stand rejected under 35 U.S.C. §102(b) as allegedly being unpatentable by *Mandelbaum* (EP Pat. Pub. No. 0671830A2). For a proper rejection of a claim under 35 U.S.C. Section 102, the cited reference must disclose all elements/features/steps of the claim. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

a. Claims 1-2, 5-11 and 13-18

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Mandelbaum* does not disclose, teach, or suggest at least the feature of

"requesting proof of the intended recipient's identity at the printout station using data in the independently verifiable data record of the intended recipient," as recited in claim 1.

*Mandelbaum* is apparently limited to at most a system wherein "a user or recipient inserts his/her smart card 175 into smart card interface 170 and enters his/her PIN number via operator panel 140" of the printer unit. Col. 6, lines 49-52. After which, "[I]n the event there have been several messages received for different recipients, as is shown in Table 404, the operator panel 140 includes buttons for enabling a recipient to select his/her messages for output from the plurality of message listed in Table 404." Col. 7, lines 7-13. Accordingly, *Mandelbaum* fails to teach or suggest the step of "requesting proof of the intended recipient's identity at the printout station using data in the independently verifiable data record of the intended recipient," since an authorized user selects a message from a list of messages for different recipients, without having to provide proof of the intended recipient's identity. Moreover, according to the teachings of *Mandelbaum*, any authorized user is able to select any message for printing. Thus, *Mandelbaum* does not anticipate claim 1, and the rejection should be withdrawn.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2, 5-11 and 13-18 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that these dependent claims 2, 5-6, 8-11, and 13-18 contain all features/elements of independent claim 1. Accordingly, the rejection to these dependent claims should be withdrawn.

b. Claims 41-43 and 46-48

Applicants respectfully submit that independent claim 41, as amended, is allowable for at least the reason that *Mandelbaum* does not disclose, teach, or suggest the features of "a store for securely retaining the transmitted document, the transmitted independently verifiable data record and the first token," "an instruction module for requesting proof of the intended recipient's identity using data provided in the intended recipient's data record," and "a controller for releasing the document when the intended recipient has proved their identity by use of a second token that is uniquely related to the first token," as recited in claim 41.

*Mandelbaum* is apparently limited to at most a system wherein "a user or recipient inserts his/her smart card 175 into smart card interface 170 and enters his/her PIN number via operator panel 140" of the printer unit. Col. 6, lines 49-52. After which, "[I]n the event

there have been several messages received for different recipients, as is shown in Table 404, the operator panel 140 includes buttons for enabling a recipient to select his/her messages for output from the plurality of message listed in Table 404." Col. 7, lines 7-13. Accordingly, *Mandelbaum* fails to teach "an instruction module for requesting proof of the intended recipient's identity using data provided in the intended recipient's data record" and "a controller for releasing the document when the intended recipient has proved their identity by use of a second token that is uniquely related to the first token," since an authorized user selects a message from a list of messages for different recipients, without having to provide proof of the intended recipient's identity. Moreover, according to the teachings of *Mandelbaum*, any authorized user is able to select any message for printing. Further, *Mandelbaum* does not disclose a store for securely retaining a first token, where the "second token that is uniquely related to the first token," as described in claim 41. Thus, *Mandelbaum* does not anticipate claim 41, and the rejection should be withdrawn.

Because independent claim 41 is allowable over the cited art of record, dependent claims 42-43 and 46-48 (which depend from independent claim 41) are allowable as a matter of law for at least the reason that these dependent claims 42-43 and 46-48 contain all features/elements of independent claim 41. Accordingly, the rejection to these dependent claims should be withdrawn.

c. Claims 54-56, 58 and 60-62

Applicants respectfully submit that independent claims 54 and 60, as amended, are allowable for at least the reason that *Mandelbaum* does not disclose, teach, or suggest the features of "obtaining a first part of an intended recipient's identifying token at the second station," "requesting proof of the intended recipient's identity at the second station using the transmitted independently verifiable data record," and "releasing the document to the intended recipient when the intended recipient has proved their identity using a second part of the recipient's identifying token," as recited in claims 54 and 60.

*Mandelbaum* is apparently limited to at most a system wherein "a user or recipient inserts his/her smart card 175 into smart card interface 170 and enters his/her PIN number via operator panel 140" of the printer unit. Col. 6, lines 49-52. After which, "[I]n the event there have been several messages received for different recipients, as is shown in Table 404, the operator panel 140 includes buttons for enabling a recipient to select his/her messages for output from the plurality of message listed in Table 404." Col. 7, lines 7-13.



Accordingly, *Mandelbaum* fails to teach "obtaining a first part of an intended recipient's identifying token at the second station," "requesting proof of the intended recipient's identity at the second station using the transmitted independently verifiable data record," and "releasing the document to the intended recipient when the intended recipient has proved their identity using a second part of the recipient's identifying token," since an authorized user selects a message from a list of messages for different recipients, without having to provide proof of the intended recipient's identity. Moreover, according to the teachings of *Mandelbaum*, any authorized user is able to select any message for printing. Further, *Mandelbaum* does not disclose a store for securely retaining a first part of an intended recipient's identifying token at a second station and then releasing the document when the intended recipient has proved their identity using a second part of the recipient's identifying token, as described in claims 54 and 60. Thus, *Mandelbaum* does not anticipate claims 54 and 60, and the rejections should be withdrawn.

Because independent claims 54 and 60 are allowable over the cited art of record, dependent claims 55-56 and 58 (which depend from independent claim 54), and dependent claims 61-62 (which depend from independent claim 60), are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of their respective independent base claim. Accordingly, the rejection to these dependent claims should be withdrawn.

6. Response to Rejection of Claims 3-4, 12, 19-40, 44-45, 49-53, 57, 59, and 63 Under 35 U.S.C. §103

In the Office Action, claims 3-4, 44-45, and 49-53 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Lundblad*. Claims 12, 40, 57, and 63 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Schneier*. Claims 19-37 and 59 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Auerbach* (EP Patent Publication No. 0798892 A2). Claims 38 and 39 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Auerbach* in view of *Schneier*.

All of the claimed features of independent claims 1, 21, 40, 41, 49, 54, and 60 are not taught and suggested by *Mandelbaum*, for at least the reasons previously discussed. Further, the cited art of *Lundblad*, *Schneier*, and *Auerbach* fails to cure the deficiencies of the *Mandelbaum* reference in suggesting or teaching all of the claimed features of the

independent claims and their respective dependent claims also. Therefore, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Mandelbaum* with the cited art has not been made. Therefore, the rejections of claims 3-4, 12, 19-40, 44-45, 49-53, 57, 59, and 63 should be withdrawn.

### ***CONCLUSION***

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

  
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